



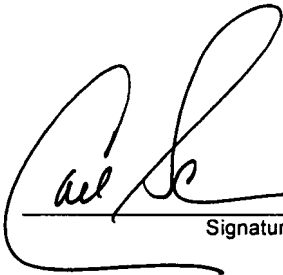
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SHO-0037	
	Application Number 10/697,026-Conf. #1078	Filed October 31, 2003	
	First Named Inventor Kazuki EMORI et al.		
	Art Unit 3714	Examiner A. Kim	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,211</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <div style="text-align: right;"> _____ Signature Carl Schaukowitch Typed or printed name  (202) 955-3750 Telephone number May 31, 2007 Date</div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of <u>1</u> form is submitted.</p>			



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Attorney Docket No.: SHO-0037

**Kazuki EMORI et al.**

Examiner: A. Kim

Application No.: 10/697,026

Art Unit: 3714

Filed: October 31, 2003

Confirmation No.: 1078

For: GAMING MACHINE HAVING TRANSPARENT OR LIGHT-REFLECTING REELS  
(As amended)

**ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW****Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The Examiner issued an Advisory Action dated April 30, 2007, in response to Applicant's Amendment after Final Rejection under 37 CFR 1.116 filed on April 5, 2007. Applicants' Amendment after Final Rejection was filed in response to the final Office Action dated February 7, 2007. A complete listing of the claims and the appropriate status identifiers can be found in Applicant's Amendment after Final Rejection on pages 3-6. No amendments were made to the claims in Applicants' Amendment after Final Rejection.

The period for response is extended to June 7, 2007, by the Petition for Extension of Time filed herewith.

In the final Office Action dated February 7, 2007, claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 102(b) as anticipated by Uchiyama et al. (U.S. Patent No. 6,638,165) with claims 1, 3, and 6 being independent claims. Also, claims 3, 6, 7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama. The rejections are respectfully traversed.

It is respectfully submitted that the Examiner fails to establish a *prima facie*

case of anticipation. The courts have required for §102 anticipation that a single reference teach (i.e., identically describe) each and every element or step of the rejected claim or else the reference falls under §103. Atlas Powder v. E. I. du Pont, 750 F.2nd 1569, 224 USPQ 409 (Fed. Cir. 1984), Jamesbury Corp. v. Litton Industrial Products, 756 F.2nd 1556, 22 5 USPQ 253 (Fed. Cir. 1985). As discussed in detail below, the Examiner fails to show each and every element of the rejected claims.

Although the reel structure and how the symbols are lit by a light source are NOT explicitly show or suggested in the drawings, Uchiyama (US'165) describes in the specification that:

drum: the mechanical reel portion 6 is a cylindrical steel wheel (column 10, line 67); the mechanical reel portion 6 may be made of plastic (column 11, lines 7-8)

illumination: light source is housed in the mechanical reel portion 6 (column 6, lines 63-64)

symbols: numbers printed on the mechanical reel portion 6 (column 6, lines 65-66)

From the above description, and the below listed reasons [A] and [B], it is more natural for one skilled in the art to perceive that Uchiyama's reels are configured to be **non-transparent cylindrical wheels** having windows opened at positions where the symbols are arranged.

[A] In the gaming machine disclosed in Uchiyama, as explained in the previous-filed Amendment, the inner side of the half-mirror 1g needs to be as dark as possible in order to show the image of symbols in good quality. This leads to the fact that only the symbols should be lit up bright and NOT the reels (annular bodies) themselves. Figures 2, 7 and 13A-13C show how the symbols should be displayed in Uchiyama, from which it is also apparent that the reels (annular bodies) themselves should NOT be displayed.

[B] The symbols are usually *printed* on a transparent symbol strip wrapped around a non-transparent cylindrical body, or directly on a transparent cylindrical body that is supported by arms extending toward a rotation shaft.

Note here that the reel structure is recited in independent claims 1, 3, 4 and 6 by either one combination of 1) symbol strip + annular body or 2) outer ring part + arm part, in the present application.

It is respectfully submitted that Applicants believe that the Examiner's viewpoint that *"the reel or annular body must indeed be at least semi-transparent"* is unduly assertive and unreasonable, and that Uchiyama does NOT explicitly disclose each and every element recited in the claims.

It is respectfully submitted that the rejection of claims 1, 3, 4 and 6 is improper under 35 USC 102(b) because the applied art fails to teach each element of claims 1, 3, 4 and 6 as discussed above. Further, it is respectfully submitted that none on the applied art, alone or in combination, teaches or suggests the features of claim 3 and 6 as discussed above. Thus, one of ordinary skill in the art would not be motivated to combine the features all the applied art because such combination would not result in the claimed invention as recited in claims 3, 6, 7 and 9-15 rejected under 35 U.S.C. 103(a). As a result, it is respectfully submitted that the dependent claims are allowable over the applied art.

Claims 7-9 and 12 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Claims 10, 14 and 17 depend from claim 3 and include all of the features of claim 3. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 3 is allowable as well as for the features they recite.

Claim 13 depends from claim 4 and includes all of the features of claim 4. Thus, it is respectfully submitted that the dependent claim is allowable at least for the reasons claim 4 is allowable as well as for the features it recites.

Claims 11, 15 and 17 depend from claim 6 and include all of the features of claim 6. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 6 is allowable as well as for the features they recite.

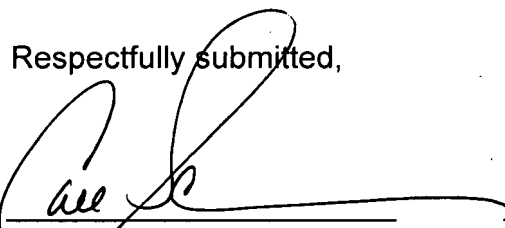
Withdrawal of the rejections is respectfully requested.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

Date: May 31, 2007

By:

  
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Enclosure(s):      Notice of Appeal  
                         Pre-Appeal Brief Request for Review  
                         Petition for Extension of Time (one month)

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